

*REMARKS/ARGUMENTS**The Pending Claims*

Claims 53-60, 63-70, 73-88, and 91-98 currently are pending. Claims 53-60, 73-80, and 91-94 are directed to a system comprising an adenoviral vector and a cell. Claims 63-70, 81-88, and 95-98 are directed to a method of propagating an adenoviral vector.

The Amendments to the Claims

Claims 53 and 63 have been amended to delete the phrase “resulting in a replication-competent adenoviral vector,” and to recite that, if the adenoviral vector is deficient in one or more essential gene functions of the E2A region and/or the E4 region, the cellular genome comprises a nucleic acid sequence that complements for the deficiency in the E2A region and/or the E4 region that is operably linked to an inducible promoter or a repressible promoter. These amendments are supported by the specification at, e.g., page 14, line 34, through page 15, line 17. No new matter has been added by way of these amendments.

The Office Action

Claims 53-60, 63-70, 73-88, and 91-98 are rejected under 35 U.S.C. § 112, first paragraph, for an alleged lack of enablement. The pending claims are rejected under the principles of res judicata and collateral estoppel with respect to Interference No. 105046. Claims 53-60, 63-70, 73-88, and 91-98 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 147, 159, 160, 176, 188, 189, and 205-255 of copending U.S. Patent Application No. 09/261,922. Reconsideration of these rejections is respectfully requested.

Discussion of Enablement Rejection

Claims 53-60, 63-70, 73-88, and 91-98 are rejected under Section 112, first paragraph, for an alleged lack of enablement. In particular, the Office Action alleges that the rejected claims are only enabled for systems and methods comprising a cell wherein the E2A region or the E4 region is operably linked to an inducible or repressible promoter. Solely in an effort to advance prosecution of the subject application, and not in acquiescence of the rejection, claims 53 and 63 have been amended to recite that, if the adenoviral vector is

deficient in one or more essential gene functions of the E2A region and/or the E4 region, the cellular genome comprises a nucleic acid sequence that complements for the deficiency in the E2A region and/or the E4 region that is operably linked to an inducible promoter or a repressible promoter. Thus, the enablement rejection under Section 112, first paragraph is moot, and the rejection should be withdrawn.

Discussion of Rejections Under the Principle of Res Judicata and Estoppel

The Office Action rejects claims 53-60, 63-70, 73-88, and 91-98 under the principles of res judicata and collateral estoppel. As suggested by the Office Action, claims 53 and 63 have been amended such that they recite “there is no overlap between the cellular genome and the adenoviral genome that mediates a recombination event between the cellular genome and the adenoviral genome.” Thus, the rejections under the principles of res judicata and collateral estoppel are moot and should be withdrawn.


Discussion of Provisional Obviousness-Type Double Patenting Rejection

Claims 53-60, 63-70, 73-88, and 91-98 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 147, 159, 160, 176, 188, 189, and 205-255 of copending U.S. Patent Application No. 09/261,922. Applicants note that copending U.S. Patent Application No. 09/261,922 is abandoned. Accordingly, the provisional rejection is improper and should be withdrawn.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Melissa E. Kolom". The signature is fluid and cursive, with the first name "Melissa" and last name "Kolom" clearly distinguishable.

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